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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,016	04/08/2004	Chiu-Chien Yuan	24061.93 (TSMC2003-0372)	9310
43717 7590 01/07/2010 HAYNES AND BOONE, LLP IP Section 2323 Victory Avenue Suite 700 Dallas, TX 75219				
EXAMINER				
SHAW, PELING ANDY				
ART UNIT		PAPER NUMBER		
2444				
MAIL DATE		DELIVERY MODE		
01/07/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/821,016

**Applicant(s)**

YUAN ET AL.

**Examiner**

PELING A. SHAW

**Art Unit**

2444

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. In view of the Appeal Brief Filed dated 10/05/2009, PROSECUTION IS HEREBY REOPENED. New grounds of rejection, i.e. claims 1-18 are rejections under 35 U.S.C. 101. Claims 1-26 are currently pending.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Amendment on the claims received on 06/12/2009 has listed claim 20 twice and is not entered into record. The Arguments as per Amendment received on 06/12/2009 was considered as per Advisory Action mailed 06/29/2009.
3. Amendment received on 01/12/2009 was entered into record. Claims 1, 3 10 and 19-26 were amended.

***Priority***

4. This application has no priority claim made. The filing date is 04/08/2004.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

- a. Claim 1 recites the limitation of “a computer-implemented method for circulating a file between the entities comprising: selecting at least one of ... input files; selecting an output file format ...; selecting a mode ...; extracting file information ...; circulating the output file to at least one recipient entity ...” wherein there is no specific hardware component that is described to be used to implement the method and thus render the claim not with proper limitations to support its described method. Claim 1 and its dependent claims 2-9 are thus rejected as not conforming 35 U.S.C. 101. For the purpose of applying art, claims 1 and 2-9 are examined as method claims of similar scope as system claims 19-26.
- b. Claim 10 recites the limitation of “a computer-implemented method for circulating a file associated with the manufacture or sale of semiconductor devices, the method comprising: closing an application file ...; querying the user if ...; if the application file is to be circulated, checking and determining ...; preparing the application file for circulation ...; and circulating the output file to at least one recipient ...” wherein there is no specific hardware component that is described to be used to implement the method and thus render the claim not with proper limitations to support its described method. Claim 10 and its dependent claims 11-18 are thus rejected as not conforming

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35 U.S.C. 101. For the purpose of applying art, claims 10 and 11-18 are examined as method claims of similar scope as system claims 19-26.

Appropriate corrections are required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7, 10-14, 16 and 19-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Lu et al. (B2B in TSMC Turnkey Services), hereinafter referred as Lu.

- a. Regarding claim 1, Lu disclosed in a semiconductor manufacturing environment with a plurality of separate entities (background), a computer-implemented method for circulating a file between the entities (last paragraph on right column of page 43 through 1st paragraph on left column on page 44: send shipping instruction to subcontractor and shipping alert to customers through a XML format and e-mail) comprising: selecting at least one of a plurality of input files (3rd paragraph on left column of page 41 and 5th paragraph on right column of page 41: entering inventory INSLIP data); selecting an output file format from a plurality of output file formats (last paragraph on right column of page 43 through 1st paragraph on left column on page 44: send in XML format); selecting a mode for circulation from a plurality of modes for circulation (last paragraph on right column of page 43 through 1st paragraph on left column on page 44: e-mail); extracting file information from the selected at least one input file to an output file in the selected output file format (last paragraph on right column of page 43 through 1st paragraph on left column on page 44: process INSLIP, send shipping instruction and shipping alert in XML format) ;

- and circulating the output file to at least one recipient entity using the selected mode for circulation (last paragraph on right column of page 43 through 1st paragraph on left column on page 44: send to subcontractors and/or customers).
- b. Regarding claim 2, Lu disclosed the computer-implemented method of claim 1, wherein the at least one input file comprises a product manufacturing report from a semiconductor foundry (4th paragraph on left column of page 41: cycle time reports and yields reports).
  - c. Regarding claim 3, Lu disclosed the computer-implemented method of claim 1, further comprising converting the at least one input file to a different file format prior to the extracting (2nd paragraph on left column of page 44: aggregate all subcontractor's information in one format).
  - d. Regarding claim 4, Lu disclosed the computer-implemented method of claim 1, wherein the mode for circulation comprises e-mail (last paragraph on right column of page 43 through 1st paragraph on left column on page 44: send through e-mail).
  - e. Regarding claim 5, Lu disclosed the computer-implemented method of claim 1, wherein the mode for circulation comprises facsimile (3rd paragraph on left column of page 44: exchange the hard copy WO and invoice through FAX).
  - f. Regarding claim 7, Lu disclosed the computer-implemented method of claim 1, wherein the at least one input file comprises at least two input files (3rd paragraph on left column of page 41 and 3rd paragraph on left column of page 42: integrate lot status (FAB + Circuit Probing + AS + FT)).

- g. Regarding claim 10, Lu disclosed a computer-implemented method for circulating a file associated with the manufacture or sale of semiconductor devices, the method comprising: closing an application file responsive to a user request (in light of paragraph 23 on pages 5-6 and paragraph 59 on page 13 of applicant's specification; 4th paragraph on left column of page 43: request for reporting system); querying the user if the application file is to be circulated (3rd paragraph on left column of page 41: report oriented, yield data, ship alarm, produced some kinds of data to ask the subcontractor to provide, electronic purchase order, confirmed shipping dates), wherein the preparing comprises converting the application file to another application file type if necessary (last paragraph on right column of page 43 through 1st paragraph on left column on page 44: process INSLIP, send shipping instruction and shipping alert in XML format); if the application file is to be circulated, checking and determining the application file type (2nd paragraph on left column of page 43: format/data type check, content context check); preparing the application file for circulation (last paragraph on right column of page 43 through 1st paragraph on left column on page 44: process INSLIP, send shipping instruction and shipping alert in XML format); and circulating the output file to at least one recipient (last paragraph on right column of page 43 through 1st paragraph on left column on page 44: send to subcontractors and/or customers) using a selected one of a plurality of circulation modes (last paragraph on right column of page 43 through 1st paragraph on left column on page 44: send to subcontractors and/or customers).



- h. Claims 11-14 and 16 are of the same scope of claims 2-5, 7 and 10. These are rejected for the same reasons as for claims 2-5, 7 and 10.
- i. Claims 19-23 are of the same scope of claims 1-5. These are rejected for the same reasons as for claims 1-5.

Lu disclosed all limitations of claims 1-5, 7, 10-14, 16 and 19-23. Claims 1-5, 7, 10-14, 16 and 19-23 are rejected under 35 U.S.C. 102(b).

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 8-9, 15, 17-18 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lu and further in view of Nicholls et al. (US 6363414 B1), hereinafter referred as Nicholls.

- a. Lu has shown claims 1, 10 and 19 substantially as claimed. Lu does not explicitly show wherein the mode for circulation comprises a wireless device. However Lu does show circulating files in FAX or e-mail (see claim 13-14 rejections above).
- b. Nicholls shows (column 1, lines 16-42) that any device capable transmitting electronic data can now send and receive e-mail message (e.g. cellular phone and hand-held computer devices having wireless communication capabilities) in an analogous art for the purpose of converting an email message to a different format

- and retransmitting to a location other than recipient address information in the email message.
- c. It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify Lu's functions of B2B in turnkey services with Nicholls' functions of transmitting e-mail in wireless communication.
- d. The modification would have been obvious because one of ordinary skill in the art would have been motivated to apply e-mail over wireless electronic data transporting capability per Nicholls as applied to the general art of e-mail communication as per Lu's (last paragraph on right column of page 43 through 1<sup>st</sup> paragraph on left column on page 44) and Nicholls (3<sup>rd</sup> paragraph in column 1)'s teaching.
- e. Regarding claim 8, Nicholls shows wherein the mode for circulation comprises sending an e-mail to at least two different entities, the at least two different entities having different e-mail systems (Fig. 2a and column 2, line 49 through column 3, line 321: internet based e-mail, delivery e-mail via facsimile, pager or telephony).
- f. Regarding claim 9, Nicholls shows wherein the mode for circulation comprises sending an e-mail to at least one entity, and sending a facsimile to at least one other entity, the at least one other entity being at a different location than the at least one entity (column 5, line 52 through column 6, line 16: received e-mail may be faxed to subscriber's home facsimile machine).
- g. Claims 15, 17-18 and 24-26 of the same scope as claims 1, 6 and 8-10. These are rejected for the same reasons as for claims 1, 6 and 8-10.

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Together Lu and Nicholls disclosed all limitations of claims 6, 8-9, 15, 17-18 and 24-26.

Claims 6, 8-9, 15, 17-18 and 24-26 are rejected under 35 U.S.C. 103(a).

***Response to Arguments***

8. Prosecution is reopened due to new grounds for rejections as per section 5 above.

Examiner's responses to applicant's arguments filed on 01/12/2009 are repeated as below per Office Action dated 04/15/2009.

- a. Applicant has amended claim language to address claim rejections and claim rejections under 35 U.S.C. 112, second paragraph as per section 3 and item c of section 4 of office action mailed on 11/03/2008. Applicant has further clarified claim rejections under 35 U.S.C. 112, second paragraph as items a and b of section 4 of office action mailed on 11/03/2008. Examiner has reviewed and accepted claim amendments and clarification. The previous claim objections and rejections under 35 U.S.C. 112, second paragraph are withdrawn.
- b. As states in item a above, applicant has amended claim 1 with the limitations of "selecting ... from a plurality of ..." and examiner does not find the support for these limitations. However, applicant does argue that Lu does not have these limitations as per 3<sup>rd</sup> paragraph on page 7 of current amendment. As one skill in the art would know that "selecting ... from a plurality of ..." is not different from "choosing at least one" unless it is more specific about what is chosen from, i.e. to narrow the selection. As Lu has shown (3rd paragraph on left column of page 41 and 5th paragraph on right column of page 41) asking some kinds of data to provide, i.e. seems to allow selecting from different inputs; (last paragraph on right column of page 43 through 1st paragraph on left column on page 44) send in XML format, FAX, e-mail and phone,

- i.e. selecting from different output (file) formats and modes. Thus Lu seems to have the amended and argued limitations.
- c. Claim rejections are updated to reflect the current amended claim changes as above.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peling A. Shaw whose telephone number is (571) 272-7968. The examiner can normally be reached on M-F 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Peling A Shaw/  
Examiner, Art Unit 2444